

REMARKS

Claims 7-18 are pending in the present application. The subject matter of the various claims was commonly owned at the time of the invention because all inventors were regular employees of the Applicant at that time of the invention and obligated to assign any patent application to the Applicant.

Claim rejection under 35 USC §103:

Claims 7-10, 12-14, and 16-18 have been rejected under 35 U.S.C. 103, as being unpatentable over Cioffi (US 4,992,752) in view of Edward et al. (US 4,825,220).

The Examiner states that Cioffi in view of Edward discloses a method of tuning an active device wherein the method includes all steps as claimed in claim 7. Applicant respectfully disagrees.

Independent Claims 7 and 13:

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. See Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner did not show a prima facie case of obviousness. The Examiner merely stated that a combination of Cioffi and Edward could teach all the limitations of the present independent claims. However, the Examiner failed to show that a person skilled in the art would have been

motivated to combine these two references. Edward is directed to a very specific field dealing with microstrip "patch" antennas as used in conventional radios. However, neither the present application nor Cioffi are directed to antennas. Thus, it is not clear why a person skilled in the art would combine the teaching of Cioffi and Edwards. Cioffi is related to an apparatus and method for adapting a plurality of amplifiers. However, Edwards concerns a microstrip printed dipole antenna. Edwards neither mentions nor suggests to modify specific elements of an amplifier, in particular impedances of an amplifier. Thus, the Examiner has not presented a prima facie case that a person skilled in the art would actually be motivated to combine these references.

Dependent Claims 8-12, and 14-18:


The dependent Claims include all the limitations of the respective independent claims. Thus, these claims are patentable at least to the extent of the independent claims.

CONCLUSION

The application as defined in the pending claims is patentable under 35 U.S.C. 103 in view of Cioffi and in further view of Edwards and Mannerstrale. Therefore, applicants respectfully request withdrawal of the rejection and allowance of all pending claims.

Applicants do not believe that any other fees are due at this time; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct the fees from Deposit Account No. 02-0383, (*formerly Baker & Botts, L.L.P.*) Order Number 071308.0221.

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